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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,902	11/02/1999	KAZUYUKI OHTSU	FUJY=16.705	9388
26304	7590	01/24/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				FERRIS, DERRICK W
			ART UNIT	PAPER NUMBER
			2663	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/431,902	OHTSU ET AL	
	Examiner Derrick W. Ferris	Art Unit 2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 December 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 2-5 is/are allowed.
- 6) Claim(s) 1 and 6-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 November 1999 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office action is in response to applicant's response filed 12/15/2004.
2. **Claims 1-8** as amended are still in consideration for this application.
3. Examiner does not withdraw the obviousness rejection to *Sieppi et al.* ("Sieppi") in view of *Vargo et al.* ("Vargo"). At issue appears to be the following limitations:

a setting section setting a compression form for compressing the data being transmitted to the Internet protocol network, wherein the compression form includes a transmission rate; and

a judging section judging whether the compression form set by the setting means coincides with the compression form of the compressed data received from the circuit switch or not

With respect to *Sieppi*, see figure 1 where the switching means (i.e., applicant's gateway apparatus) performs the setting and judging sections, the circuit switched network is from the MS to the switching means, and the Internet is labeled Internet. At issue, appears to be *how* a setting section sets a compression which is not further recited in the claims. In addition, it is noted that the examiner construes the circuit switched network to be between the mobile and the switching means and not a *different* circuit switched network 2 attached to a second gateway 20 in light of applicant's specification but not further recited in the claims. With respect to *Sieppi*, the above limitation is met since the states appear to be set beforehand or preconfigured based on two states as taught e.g., at column 7, lines 14-22. With respect to a judging section, the above limitation is met based on the call setup message which is the compressed data sent from the first

mobile station of the circuit switched network. In particular, the call setup message is sent to the switch determining means which determines what type of compression to set for the CODEC in the BSC based on the capabilities on a second station found on the Internet such as the WS for the IP network shown in figure 1 of *Sieppi*. Specifically, a judging section is further taught at e.g., column 6, lines 10-24; column 7, lines 23-40; and column 9, lines 3-20 of *Sieppi*. The examiner would like to further point out that *how* a judging section judges is not further recited in the claims. Hence both the above limitations are taught by the reference.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 7, and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,577,637 B1 to *Sieppi et al.* (“*Sieppi*”) in view of U.S. Patent No. 6,356,545 B1 to *Vargo et al.* (“*Vargo*”).

As such to **claim 1**, *Sieppi* discloses e.g., in figure 1 a circuit switched network as part of the wireless network and an Internet protocol network as the Internet. As such, the gateway as taught as the combination of the BSC and the MSC/VLR in figure 1 or equivalent where the SSTDM performs the judging section and the setting section is performed based on the two states of the CODEC, see e.g., column 7, lines 13-40 and column 12, lines 26-50. In particular, the subscriber station type determining means (SSTDM) determines the type of connection for the IP terminal since it is assumed that

the first station in the wireless network always uses a CODEC, see e.g., column 9, lines 43-54. Thus the subscriber station type determining means determines if the second station uses a CODEC. If the second station uses a CODEC (i.e., the compression forms coincide) then no compression is performed at the “gateway” (i.e., a pass through state is performed at the controller) and if the second station does not use a CODEC (i.e., the compression forms do not coincide) then compression is performed at the “gateway” (i.e., the compressed data received from the circuit switched network is expanded by the expansion section and then compressed by the compression section). In other words, a judgment is made by the SSTDM based on whether compression is set or not at the IP network. When compression is set for the IP side of the link then a pass-through is performed (i.e., no processing of the CODEC or expansion/compression) in order to avoid double compression, otherwise compression is performed.

Sieppi may silent or deficient to the further limitation of the expanded data expanded by the expansion section is compressed by said compression section *at the compression for set by said setting section*. In particular, it may not be clear from *Sieppi* what CODEC is selected if a pass-thought is not performed.

Vargo teaches the further recited limitation above at e.g., the background at column 2, line 7-26. In particular, *Vargo* teaches that one skilled in the art would know to match the CODECs at either end of a communications link.

The proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Sieppi* by clarifying that the CODEC selected compresses the data that matches the other side of the link.

As such, examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the above limitation. In particular, the motivation for modifying the reference or to combine the reference teachings would be to match the compression used at either end of the link. In particular, *Vargo* cures the above-cited deficiency by providing a motivation found at e.g., the background at column 2, line 7-26. Second, there would be a reasonable expectation of success since both references teach using CODECs. Thus the references either in singular or in combination teach the above claim limitation(s).

As to **claim 7**, see similar rejection to claim 1 where a lower-order network is the wireless network and a high-order network is the Internet.

As to **claim 8**, see similar rejection to claim 1 where a high-order network is the wireless network and a low-order network is the Internet.

Allowable Subject Matter

6. **Claims 2-5** are allowed.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

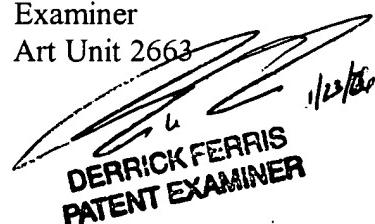
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (571) 272-3123. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571)272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DWF

Derrick W. Ferris
Examiner
Art Unit 2663


DERRICK FERRIS
PATENT EXAMINER
1/23/04